

REMARKS

Applicant is in receipt of the Office Action mailed July 22, 2004. Claims 43, 44, and 46-60 remain pending in the case. Further consideration of the present case is earnestly requested in light of the following remarks.

Provisional Obviousness-Type Double Patenting Rejection

Claim 43 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of copending Application No. 09/737,528, and also over U.S. Patent No. 5,818,446 to Bertram et al. ("Bertram").

Regarding copending Application No. 09/737,528, Applicant will shortly file a Terminal Disclaimer for the present application with respect to the cited application, as well as a Power of Attorney By Assignee and Revocation of Previous Powers. Removal of the provisional rejection is respectfully requested.

Regarding the Bertram patent, Applicant respectfully submits that the judicially created doctrine of obviousness-type double patenting does not apply to patents and applications that were not commonly assigned at the time of the invention, and so the provisional rejection of the present application over Bertram is improper.

Section 102 Rejections

Claim 59 was rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,818,446 to Bertram et al. ("Bertram"). Applicant respectfully disagrees.

As the Examiner is certainly aware, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 59 recites:

59. A system for configuring a graphical user interface (GUI) element to publish or subscribe to a data target or data source, respectively, the system comprising:

a display device;

a processor;

a memory medium coupled to the processor, wherein the memory medium stores a first program;

wherein the processor is operable to execute the first program to:

receive user input specifying a data source, wherein said receiving user input specifying a data source comprises receiving user input specifying a uniform resource locator (URL) of the data source;

programmatically select a GUI element after receiving the user input, wherein the GUI element is selected based on a data type of the data source;

display the selected GUI element in the program after said programmatically selecting; and

programmatically configure the GUI element to receive and display data from the specified data source.

The Office Action asserts that Bertram teaches all the limitations of claim 59. Applicant respectfully disagrees. For example, the Office Action attempts to equate Bertram's browser window with the programmatically selected GUI element of claim 59. However, Applicant notes that in Bertram's system (and other browser-based systems) the browser window, e.g., in the form of HTML or other webpage markup language instructions, is transmitted from the data source, e.g., along with the data to be displayed. In other words, Bertram's "GUI element" (browser window) is not selected by a first program executing on the (host) computer system based on and in response to the data type of the data source, but rather is specified and provided by the data source. Said another way, Bertram teaches that the data source sends the data *and* the browser window information, and thus, no "selection" of a GUI is performed by a first program based on data type. Thus, Applicant submits that Bertram fails to teach or suggest the processor being operable to *execute the first program to programmatically select a GUI element*

after receiving the user input, wherein the GUI element is selected based on a data type of the data source.

Thus, for at least the reasons provided above, Applicant respectfully submits that Bertram neither teaches nor suggests the features and limitations of claim 59, and so claim 59, and claims dependent thereon, are unobvious and patentably distinguishable over the cited art, and are thus allowable. Removal of the 102 rejection of claim 59 is respectfully requested.

Section 102 Rejections

Claims 43-44, 46-58, and 60 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,861,882 to Sprenger et al. (“Sprenger”), over U.S. Patent No. 6,560,557 to Carnahan et al. (“Carnahan”), and also over U.S. Patent No. 5,818,446 to Bertram et al. (Bertram). Applicant respectfully disagrees.

As the Examiner is certainly aware, to establish a prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. In re Bond, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

Moreover, as held by the U.S. Court of Appeals for the Federal Circuit in *Ecolochem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis.

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Claim 43 recites:

43. A memory medium comprising program instructions for configuring a graphical user interface (GUI) element to subscribe to data source, wherein the program instructions are executable to implement:

receiving user input specifying a data source, wherein the user input is received to a program development environment during creation of a program, and wherein said receiving user input specifying a data source comprises receiving user input specifying a uniform resource locator (URL) of the data source;

programmatically selecting a GUI element after receiving the user input, wherein the GUI element is selected based on a data type of data provided by the data source;

displaying the selected GUI element in the program after said programmatically selecting; and

programmatically configuring the GUI element to receive and display data from the specified data source.

Applicant respectfully submits that neither Sprenger, Carnahan, nor Bertram provides a motivation to combine, and that even were Sprenger, Carnahan, and Bertram properly combinable, which Applicant argues they are not, the resulting combination would still not produce Applicant's invention as claimed.

For example, nowhere does Sprenger suggest, or even hint at a URL, much less, using a URL to specify a data target, nor *programmatically selecting a GUI element* at all. As described in the cited portions of Sprenger, Sprenger teaches the specification and assembly of a test circuit via a user dragging and dropping test element icons, e.g., representing oscilloscopes, baseband analyzers, multi-meters, filters, etc., as well as a DUT (device under test) icon, into a window, and coupling these icons together, thereby forming a test circuit for testing the DUT, where the test element icons are expandable or enlargeable to operate as GUI elements for receiving and displaying data from other test elements represented by coupled icons.

The Office Action asserts that Sprenger teaches "receiving user input specifying a data source, wherein the user input is received to a program development environment during creation of a program; displaying a selected GUI element in the program; and

programmatically configuring the GUI element to receive and display data from the specified data source”, but admits that Sprenger does not disclose the user input specifying the data source as a URL, nor selection of the GUI element (after receiving the user input) based on a data type of data provided by the data source.

Applicant respectfully submits that the Examiner has mischaracterized Sprenger, and that there are numerous other features and limitations of claim 43 that Sprenger fails to teach or suggest. For example, the Office Action describes Sprenger’s “receiving user input specifying a data source” and “displaying a selected GUI element in the program” as two distinct method elements, yet, as Sprenger clearly describes in the cited col. 6, line 51 – col. 7, line 8; and col. 7, lines 44-50, the user manually “drags and drops” test element icons onto the Test Bench window, thereby specifying data coupling between corresponding test elements *and also* specifying the “GUI elements” (as characterized by the Examiner), since each test element icon is its own GUI element. In other words, in Sprenger’s system, the user input *manually* specifies the data source and the GUI element for displaying data from the data source, i.e., by the same means of dragging and dropping test element icons onto the Test Bench Window.

In contrast, claim 43 describes: receiving user input specifying a data source, ...and programmatically selecting a GUI element *after receiving the user input*. In other words, the GUI element is selected *programmatically*, not manually, and furthermore, is programmatically selected *after*, i.e., separate from, the user input specifying the data source, whereas Sprenger *manually* specifies/selects both the data source and the GUI element via the same means. Thus, Applicant submits that not only does Sprenger fail to teach these features and limitations of claim 43, but actually teaches *away* from Applicant’s invention as claimed.

Similarly, Carnahan does not provide a motivation to combine with Sprenger or Bertram, and neither mentions nor hints at *programmatically selecting a GUI element in response to a data type from a specified data source*. Rather, as described in the Summary and elsewhere, Carnahan teaches:

The client graphical user interface permits the user to request active instrument panel pages from a server. The server includes an active server page, Active-X, and a standard instrument control library. The active server page

is a page that emulates an instrument panel and includes remote scripting interfaces to provide constant update of the instrument panel page.

In other words, in Carnahan's system, the user *manually* requests and receives the GUI element for displaying data from a specified data source (the remote instrument or device) from a server. Again, nowhere does Carnahan teach or suggest *programmatically selecting a GUI element* after receiving the user input, and based on the type of data from a specified data source.

Applicant submits that Bertram also fails to provide a motivation to combine with Sprenger and/or Carnahan, and submits that nowhere does Bertram even mention a URL, nor does Bertram suggest or hint at *programmatically selecting a GUI element* based on the type of data from a specified data source. Rather, as described in detail above, in Bertram's system, the GUI element is *manually* selected by the user as an inherent part of specifying the data source, i.e., by user-selection of test element icons that also serve as GUI elements.

Applicant reminds the Examiner that, per *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985), it is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor. Applicant respectfully submits that the Examiner has attempted to produce Applicant's invention as represented by claim 43 by selecting particular portions of the cited references using claim 43 as a "blueprint", and thus submits that the attempted combination is improper.

Thus, for at least the reasons provided above, Applicant submits that neither Sprenger, Carnahan, nor Bertram, either singly or in combination, teaches or suggests all the features and limitations of claim 43, and so claim 43, and those claims dependent therefrom, are patentably distinct and non-obvious over the cited art, and are thus allowable. Independent claims 57, 58, and 60 include similar limitations as claim 43, and so the above arguments apply with equal force to these claims. Thus, for at least the above reasons, Applicant submits that claims 57, 58, and 60, and those claims

respectively dependent therefrom, are similarly patentably distinct and non-obvious over the cited art, and are thus allowable.

Removal of the 103 rejection of claims 43-44, 46-58, and 60 is respectfully requested.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

In light of the foregoing amendments and remarks, Applicant submits the application is now in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-50800/JCH.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

Respectfully submitted,



Jeffrey C. Hood
Reg. No. 35,198
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert & Goetzel PC
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8800

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